



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/529,943

04/01/2005

Masayo Matsumoto

123214

8052

25944 7590 04/28/2010
OLIFF & BERRIDGE, PLC
P.O. BOX 320850
ALEXANDRIA, VA 22320-4850

EXAMINER

HOLCOMB, MARK

ART UNIT

PAPER NUMBER

3686

NOTIFICATION DATE

DELIVERY MODE

04/28/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

OfficeAction25944@oliff.com
jarmstrong@oliff.com

Office Action Summary	Application No. 10/529,943	Applicant(s) MATSUMOTO ET AL.	
	Examiner MARK HOLCOMB	Art Unit 3686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 February 2010 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. This action is in reply to the amendment filed 16 February 2010, on an application filed 1 April 2005, which claims priority to a PCT application filed 30 September 2003 and a foreign application with a filing date of 2 October 2002.
2. **Claims 1-11 and 24-31** have been canceled.
3. **Claims 32-41** have been added by amendment, and are currently pending.

Drawings

4. The replacement drawings for Figure 8 were received on 16 February 2010. These drawings are accepted.

Note to Applicant Regarding Claim Interpretation

5. The use of the limitations "configured to", "capable of" or "adapted to" in the claims may be interpreted as intended use. Intended use/functional language does not

require that reference specifically teach the intended use of the element. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. **Claims 40 and 41** are rejected under 35 U.S.C. 102(e) as being anticipated by Teller et al. (U.S. Patent Number 6,605,038 B1), hereinafter Teller.

As per **claim 40**, Teller discloses a *measuring device carried by a subject and measuring activity of the*

Subject (Teller, Abstract), comprising:

- *a sensor adapted to measure movement of the subject (Teller, Fig. 11 and corresponding text),*
- *a memory storing an activity data, the activity data showing intensity of activity of the subject, the intensity of activity having been determined from the measured movement of the subject (Teller, Fig. 2 #22, and corresponding text and Tables 1 and 2 in Columns 4-6), and*
- *a display configured to display changes over time in the activity data within a predetermined period and a total of consumption of energy by exercise calculated based on the activity data within the predetermined period (Teller, Figures 7-11 and corresponding text, and Tables 1 and 2 in Columns 4-6),*

As per **claim 41**, Teller discloses claim 40, detailed above. Teller also discloses a measuring device *further comprising an input part inputting a beginning point of the display of the changes over time in the activity data (see at least Teller, Fig. 18 #470 and corresponding text), wherein, in the display, the changes over time in the activity data within the predetermined period are displayed from this input beginning point (see at least Teller, Col. 9, lines 14-26).*

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

11. **Claims 32, 36, 38 and 39** are rejected under 35 U.S.C. 103(a) as being unpatentable over Teller in view of Ohlenbusch, et al. (U.S. Patent Number 6,493,652 B1), hereinafter Ohlenbusch.

As per **claims 32 and 36**, Teller discloses:

- *a measuring device carried by a subject, the measuring device measuring activity of the subject (Teller, Abstract and Fig. 1 and corresponding text), and*
- *a data processing device connected with the measuring device for mutual communication, the data processing device processing activity data obtained by the measuring device (Teller, Fig. 1 and corresponding text), wherein*
 - *the measuring device comprises a sensor adapted to measure movement of the subject, a memory storing the activity data showing intensity of activity of the subject, the intensity of activity having been determined from the measured movement of the subject (Teller, Fig. 2 #22 and corresponding text and Tables 1 and 2 in Columns 4-6), and*
 - *a data transmitting part configured to transmit the activity data stored in the memory to the data processing device (Teller, Fig. 1 and corresponding text),*
 - *the data processing device comprises a data receiving part configured to*

- receive the activity data transmitted from the data transmitting part of the measuring device (Teller, Figures 1, 3 and 4, and corresponding text),*
- *and a data processing part configured to output a health management report based on the received activity data (see at least Teller, Figures 5-11 and corresponding text),*
 - *the health management report includes a first graph displaying changes over time in the activity data for one day and a second graph displaying a total of time for each state of exercise, these total of time having been obtained by dividing the activity data obtained within the one day into a plurality of states of exercise corresponding to intensity of activity (Teller, Fig. 7, #205 and #210, and corresponding text),*
 - *the first graph has a first vertical axis and a first horizontal axis, time being on the first horizontal axis, and the state of exercise being on the first vertical axis ... (Teller, Fig. 7 and corresponding text),*
 - *the second graph is disposed on right side of the first graph ... (Teller, Fig. 7 and corresponding text).*

As per the limitation concerning *the first graph has a first vertical axis and a first horizontal axis*, Teller fails to explicitly disclose, but Ohlenbusch succeeds in disclosing wherein a *second graph has a second vertical axis and a second horizontal axis, the total of time being on the second horizontal axis, and the state of exercise being on the*

second vertical axis (Ohlenbusch, Figures 8 and 38, and corresponding text),

As per the limitation concerning *the second graph is disposed on right side of the first graph* Teller fails to explicitly disclose, but Ohlenbusch succeeds in disclosing wherein *first and second horizontal axes are disposed coaxially, and the length of the first vertical axis is equal to the length of the second vertical axis, and the scale of the first vertical axis is equal to the scale of the second vertical axis* (see at least the page of Ohlenbusch that displays the two graphs of Figures 29A and 29B).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Teller with the device for monitoring activity of a user in locomotion on foot of Ohlenbusch, because to do so would result in a system for monitoring health, wellness and fitness that "can be used across different training regimes" (Ohlenbusch, Col. 1, lines 60-61). Moreover, merely adding a well-known element into a well known system, to produce a predictable result to one of ordinary skill in the art, does not render the invention patentably distinct over such combination (see MPEP 2141).

As per **claim 38**, Teller/Ohlenbusch disclose claim 36, detailed above. Teller also discloses *a data processing part configured to delete certain activity data from the received activity data, and calculate a state of activity* (Teller, Figures 3 and 4 and

corresponding text). Teller fails to explicitly disclose, but Ohlenbusch succeeds in disclosing a device wherein *the deleted activity data being: activity data wherein intensity of activity is outside a predetermined threshold range and is continued longer than a predetermined period, or activity data wherein a number of steps within a predetermined period is outside a predetermined threshold range, this number of steps having been calculated from the activity data* (Ohlenbusch, Figures 7 and 8, and corresponding text). The motivation for making this modification of the teachings of Teller is the same as that set forth, above, in the rejection of **claim 36**.

As per **claim 39**, Teller/Ohlenbusch disclose claim 36, detailed above. Teller also discloses a data processing device *further comprising:*

- *a memory accumulating and storing the received activity data* (Teller, Figures 1, 3 and 4, and corresponding text),
- *an input part for inputting a period wherein state of activity of the subject is evaluated* (Teller, Figures 3 and 4 and corresponding text), *and*
- *a data processing part configured to calculate the state of activity of the subject from the activity data stored in the memory* (Teller, Figures 3 and 4 and corresponding text),
 - *these activity data having been obtained within the input evaluating period, wherein calendar data is inserted at a predetermined time period into the activity data received by the data receiving part* (Teller, Fig. 11 and

corresponding text),

- *and wherein the data processing part specifies activity data occurring within the input evaluating period out of the activity data stored in the memory, this specification being performed on the basis of the calendar data inserted into the activity data, and the data processing part calculates the state of activity from the specified activity data* (Teller, Fig. 11 and corresponding text).

12. **Claims 33-35 and 37** are rejected under 35 U.S.C. 103(a) as being unpatentable over Teller in view of Ohlenbusch, further in view of Hinnebusch (U.S. Pre-Grant Publication Number 2002/0055419 A1), hereinafter Hinnebusch.

As per **claims 33 and 37**, Teller/Ohlenbusch disclose claims 32 and 36, respectively, as detailed above. Teller further discloses *wherein the health management report includes the first graph ... for each day of a week ...* (Teller, Fig. 11 and corresponding text).

Teller fails to explicitly disclose, but Hinnebusch succeeds in disclosing a *second graph for each day of a week, and the first graph and the second graph are arranged in order in a vertical direction* (see at least the vertical display of multiple graphs for every day of the week of Hinnebusch, Figure 9 and corresponding text). It would have been obvious

to one of ordinary skill in the art at the time of the invention to combine the teachings of Teller/Ohlenbusch with the system to improve fitness training of Hinnebusch, because to do so would result in a system for monitoring health, wellness and fitness that "makes available a library of preprogrammed exercises, preferably with means for modify a routine ... or for creating a new routine" (Hinnebusch, paragraph 2). Moreover, merely adding a well-known element into a well known system, to produce a predictable result to one of ordinary skill in the art, does not render the invention patentably distinct over such combination (see MPEP 2141).

As per **claim 34**, Teller/Ohlenbusch/Hinnebusch disclose claim 33, detailed above.

Teller further discloses:

- *wherein the measuring device further comprises a first timer and a first calendar part configured to produce a calendar date based on the time kept by the first timer (Teller, Col. 7, lines 1-37),*
- *wherein the data processing device further comprises*
 - *a second timer, a second calendar part configured to produce calendar data for correction, the calendar data for correction being based on the time kept by the second timer (Teller, Fig. 6 and corresponding text),*
 - *and a data transmitting part configured to transmit the calendar data for correction to the measuring device (Teller, Col. 9, lines 27-41),*
 - *and wherein the measuring device further comprises a data receiving part*

configured to receive the calendar data for correction, and the first timer is configured to be corrected on the basis of the received calendar data for correction (Teller, Col. 9, lines 27-41).

As per **claim 35**, Teller/Ohlenbusch/Hinnebusch disclose claim 33, detailed above.

Teller also discloses *wherein the measuring device further comprises*

- *a calendar data insert part configured to insert calendar data, which have been produced within each first predetermined period, into the activity data, the activity data being produced within each second predetermined period and being stored in the memory (Teller, Fig. 2 and corresponding text),*
- *and an activity data correcting part configured to correct the activity data stored in the memory (Teller, Fig. 2 and corresponding text), the activity data correcting part being performed on the basis of a period for producing activity data, the period being specified from the calendar data inserted into the activity data, and*

With regard to the limitation *means for correcting the activity data*, Teller fails to explicitly disclose, but Ohlenbusch succeeds in disclosing *the activity data correcting part being performed on the basis of a period for producing activity data, the period being specified from the calendar data inserted into the activity data*, (Ohlenbusch, Figures 10-13 and corresponding text).

Teller also fails to explicitly disclose, but Ohlenbusch succeeds in disclosing *wherein the activity data correcting part performs the following:*

- *in a case where a plurality of items of activity data for same period are stored, anyone of these plurality of items of activity data is retained and the other items are deleted* (Ohlenbusch, Figures 14-19 and corresponding text),
- *and in a case where the activity data has a blank period in which no activity data has been produced, dummy data is inserted into the blank period* (Ohlenbusch, Figures 14-19 and corresponding text).

The motivation for making this modification of the teachings of Teller is the same as that set forth, above, in the rejection of **claim 32**.

Response to Amendments

13. The objection to **claim 10** is withdrawn in light of the cancellation of claim 10.

14. The rejection of **claims 1-11 and 24-31** under 35 USC 102(a) and 35 USC 103(b) over the applied prior art are withdrawn in light of the cancellation of these claims.

Response to Arguments

15. Applicant's arguments filed 16 February 2010 with respect to new **claims 32 and 36**, and their corresponding dependent claims, **33-35 and 37-39**, respectively, have been fully considered but are moot in view of the new ground(s) of rejection, specifically with reference to the new citation of previously applied prior art as necessitated by amendment, Ohlenbusch, as well as the new reference necessitated by amendment, Hinnebusch, as detailed above.

16. Applicant's arguments filed 16 February 2010 with respect to new **claim 40**, and the corresponding dependent claim, **41**, have been fully considered but are not persuasive.

With regard to new **claim 40**, Applicant argues on page 10 that "Teller fails to disclose that the sensor device comprises the display that displays changes in the activity data within a predetermined time period and a total consumption of energy." The Applicant respectfully disagrees. As shown above, Teller discloses the display of changes in the activity data over a predetermined time period. See the varying activity levels displayed over different time periods in Figures 7 and 11. Teller also discloses a device that

displays a total consumption of energy (Tables 1 and 2, and Figures 7-11 and corresponding text).

The Examiner further notes that the display is a computer screen, which can be *carried by a subject*. Further, the recitation *carried by a subject* has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

17. In conclusion, all of the limitations which Applicant disputes as missing in the applied references, including the features newly added in the 16 February 2010 amendment, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the collective teachings of Teller, Ohlenbusch and Hinnebusch, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the present Office Action and in the prior Office Action (14 October 2009), and incorporated herein.

Conclusion

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Mark Holcomb**, whose telephone number is **571.270.1382**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **Jerry O'Connor**, can be reached at **571.272.6787**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

/M. H./
Examiner
10 April 2010
Art Unit 3686

/Gerald J. O'Connor/
Supervisory Patent Examiner
Group Art Unit 3686